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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
ADDY, THUAN KNOWLIN				
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06/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,236

Applicant(s)

MASUDA, KATSUYUKI

Examiner

THJUAN K. ADDY

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on March 19, 2008 has been entered. Claim 4 has been amended. No claims have been cancelled. Claims 5-8 have been added. Claims 1-8 are now pending in this application, with claims 1 and 6 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano (US 6,836,668), in view of Valentine et al. (US 6,363,253).
3. In regards to claims 1, 6, 7, and 8, Nakano discloses a mobile phone system (See Fig. 1 – Fig. 2) which performs communication between a mobile phone terminal (See Fig. 1 and portable telephone terminal) and an opposite party terminal (e.g., receiving/opposite party) via a network, wherein the mobile phone terminal comprises means for transmitting a connection request of a packet switching line to the side of the network in addition to a calling connection request of a circuit switching line to the opposite party terminal or a calling connection response of a circuit switching line to the opposite party terminal in response to key operation of a user (for example, the key

operation is performed by the user via keypad 10, See col. 4-5 lines 66-4), and means (See Fig. 2 and voice-to-character data converter 62) for transmitting data (e.g., character) corresponding to a desired voice message via a packet switching line connected with the network on the basis of the connection request (See col. 5 lines 37-53 and col. 6 lines 32-50), and a voice from the opposite party terminal is transmitted to the mobile phone terminal via the circuit switching line, while data from the mobile phone terminal is converted to a voice message by the data/voice message converting means to be transmitted to the opposite party terminal via the circuit switching line (See col. 1-2 lines 55-8 and col. 5-6 lines 37-5). Nakano, however, does not disclose the network comprises data/voice message converting means for converting data transmitted from the mobile phone terminal via the packet switching line to corresponding voice message, and means for merging the converted voice message to the circuit switching line to transmit the same to the opposite party terminal. Valentine, however, does disclose the network (See Fig. 2 and IP-based Cellular Network 10) comprises data/voice message converting means (e.g., Base Transceiver Station (BTS) 24 and Gateway 150, which are apart of IP-based Cellular Network 10, See Fig. 2) for converting data transmitted from the mobile phone terminal (See Fig. 2 and Mobile Station (MS) 20) via the packet switching line (See Fig. 2 and IP Packets 135) to corresponding voice message, and means for merging the converted voice message to the circuit switching line (See Fig. 2 and PSTN/PLMN 160) to transmit the same to the opposite party terminal (See Fig. 2 and called party 100) (See col. 3 lines 11-60). Therefore, it would have been obvious for one of ordinary skill in the art at the time of

the invention to incorporate these features within the system, as a way of establishing a call connection with a cellular network, and specifically to reducing the call setup time for calls within an Internet Protocol based cellular network.

4. In regards to claim 2, Nakano discloses a mobile phone system, wherein the mobile phone terminal further comprises means for prohibiting transmission of the voice from the mobile phone terminal to the side of the network via the circuit switching line when the means for transmitting a connection request of a packet switching line to the side of the network is actuated (See col. 1 lines 55-64, col. 5 lines 37-53, and col. 6 lines 32-50).

5. In regards to claim 3, Nakano discloses a mobile phone system, wherein the network further comprises notification means, and when the means for transmitting a connection request of a packet switching line to the side of the network is actuated, the notification means notifies that the user of the mobile phone terminal has set a mode (e.g., first/voice-character communication mode or second/character-voice communication mode) (for example, the mode is set via key operation which is performed by the user via keypad 10, See col. 4-5 lines 66-4) where data is converted to a voice message to be transmitted without transmitting a voice of the user via the circuit switching line to the opposite party terminal as a voice message (See col. 1 lines 55-64, col. 5-6 lines 54-5, and col. 6 lines 16-31).

6. In regards to claims 4 and 5, Nakano discloses a mobile phone system, wherein the means for transmitting data corresponding to a desired voice message, with which the mobile phone terminal is provided, transmits data corresponding to the desired

voice message in response to key inputting of the user (for example, the key inputting of the user is performed via keypad 10, See col. 4-5 lines 66-4) (See col. 5 lines 37-53 and col. 6 lines 32-50).

Response to Arguments

7. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fellenstein et al. (US Patent Application, Pub. No.: US 2003/0233231 A1) teach an apparatus and method for managing privacy using voice recognition and caller identification. Fellingham et al. (US 6,292,553) teach a method and apparatus for IP network call delivery.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THJUAN K. ADDY whose telephone number is (571)272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thjuan K. Addy/
Primary Examiner, Art Unit 2614